

REMARKS/ARGUMENTS

Claims 1-3, 5-10, 12-17 and 19-21 are pending in the present application. Claims 1-3, 5-6, 8-10, 12-13, 15-17 and 19-20 were amended; and claim 21 was added. No claims have been canceled. Reconsideration of the claims is respectfully requested in view of the above amendments and the following comments.

I. 35 U.S.C. § 102, Anticipation

In the Final Office Action dated July 5, 2007, the Examiner finally rejected claims 1-3 and 5 under 35 U.S.C. § 102(e) as being anticipated by Merchant et al., US Patent No. 6,772,322 B1 (hereinafter “Merchant”). This rejection is respectfully traversed.

Claim 1, as amended herein, is as follows:

1. A method for executing instructions in a data processing system, comprising:
 - associating one or more instructions of a computer program with one or more performance indicators;
 - storing the one or more performance indicators in one or more performance indicator fields of a page table;
 - initiating one or more counter fields in the page table for the one or more instructions in association with corresponding performance indicators of the one or more performance indicators;
 - incrementing counter values in the one or more counter fields during execution of an instruction of the computer program based on whether the instruction has an associated performance indicator in a performance indicator field of the page table;
 - storing one or more threshold values in one or more threshold fields of the page table in association with the one or more performance indicator fields and the one or more counter fields, wherein each of the one or more threshold values specifies a maximum counter value in an associated counter field; and
 - generating a selected action in response to the counter value in an associated counter field exceeding the threshold value in an associated threshold field.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Merchant does not teach every element of the claimed invention arranged as they are in the claims, and, accordingly, does not anticipate the claims. With respect to claim 1, in particular, Merchant does not

disclose or suggest “storing one or more threshold values in one or more threshold fields of the page table in association with the one or more performance indicator fields and the one or more counter fields, wherein each of the one or more threshold values specifies a maximum counter value in an associated counter field”, or “generating a selected action in response to the counter value in an associated counter field exceeding the threshold value in an associated threshold field.”

In the Response to Office Action filed January 4, 2007, Applicants contended that Merchant did not disclose storing threshold values in threshold fields of a page table in association with performance indicator fields and counter fields. In the Final Office Action dated July 5, 2007, the Examiner disagreed contending that Merchant discloses in Column 6, lines 55-65 matching current events with a stored specific event/threshold, and based on the results generates tags with corresponding instructions (see page 7 of Final Office Action).

Applicants continue to believe that matching current events with a stored specific event is not the same as “storing one or more threshold values in one or more threshold fields of the page table” as recited in claim 1. To better emphasize the differences between Merchant and the present invention, however, claim 1 has been further amended to now recite “storing one or more threshold values in one or more threshold fields of the page table in association with the one or more performance indicator fields and the one or more counter fields, wherein each of the one or more threshold values specifies a maximum counter value in an associated counter field”.

Assuming *arguendo*, that the stored specific event in Merchant can be construed as a threshold value, Merchant does not disclose that each of one or more threshold values specifies a maximum counter value in an associated counter field.

Further, claim 1 has been amended to also recite “generating a selected action in response to the counter value in an associated counter field exceeding the threshold value in an associated threshold field.” Again, even if the stored specific event in Merchant can be construed as a threshold value and if tags are generated based on the stored specific event matching a current event, Merchant still does not disclose or suggest generating a selected action in response to a counter value in an associated counter field exceeding a threshold value in an associated threshold field.

Claim 1, accordingly, is not anticipated by Merchant and patentably distinguishes over Merchant in its present form.

Claims 2, 3 and 5 depend from and further restrict claim 1 and are also not anticipated by Merchant, at least by virtue of their dependency.

Therefore, the rejection of claims 1-3 and 5 under 35 U.S.C. § 102 has been overcome.

II. 35 U.S.C. § 103, Obviousness

In the Final Office Action dated July 5, 2007, the Examiner finally rejected claims 6-10, 12-17, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Merchant in view of Roth et al , US Patent No. 5,937,437 (hereinafter “Roth”). This rejection is respectfully traversed.

Initially, independent claims 8 and 15 have been amended in a similar manner as claim 1. Roth does not supply the deficiencies in Merchant as discussed above with respect to claim 1. Therefore, claims 8 and 15 patentably distinguish over Merchant in view of Roth.

Claims 6-7, 9-10, 12-14, 16-17, 19 and 20 depend from and further restrict one of independent claims 1, 8 and 15, and also patentably distinguish over Merchant in view of Roth, at least by virtue of their dependency.

Therefore, the rejection of claims 6-10, 12-17, 19 and 20 under 35 U.S.C. § 103 has been overcome.

Claim 21 has been added to more fully protect Applicants’ invention, and recites the present invention in substantial detail. Claim 21 also patentably distinguishes over the cited art in its present form.

III. Conclusion

For at least all the above reasons, claims 1-3, 5-10, 12-17 and 19-21 patentably distinguish over the cited art and this application is believed to be in condition for allowance. It is, accordingly, respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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